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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,314	11/14/2003	Andrew R. Rolfe	AUT-P-0021 (8423/90907)	2749
24628	7590	08/23/2006	EXAMINER REVAK, CHRISTOPHER A	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			ART UNIT 2131	PAPER NUMBER

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/714,314	ROLFE, ANDREW R.	
	Examiner	Art Unit	
	Christopher A. Revak	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/14/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>see attached</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements submitted are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 and 29-44 of copending Application No. 10/155,821. Although the conflicting claims are not

identical, they are not patentably distinct from each other because claims 1-22 of the instant application are envisioned by copending claims 1-20 and 29-44 in that the claims of the copending application contains all the limitations of claims 1-22 of the instant application. Claims 1-22 of the instant application therefore are not patentably distinct from the earlier filed copending claims, and as such, are unpatentable for obvious-type double patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5,9-12,14-18,20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Pickett, US Patent 6,012,144.

As per claim 1, it is taught by Pickett of a secure system for capturing electronic signatures comprising a switched telephone network-type communication system and a second system different from the first system at least in part executable instructions for communicating with a party via the second system; executable instructions for obtaining a telephone number for the party, usable to initiate communications via the telephone system, executable instructions for presenting a document to the party; executable

instructions to contact the party via the telephone system; and executable instructions to obtain an indication from the party relative to proceeding with the document (col. 2, line 49 through col. 3, line 14; col. 6, lines 35-44; and as shown in Figure 1).

As per claim 2, it is disclosed by Pickett of instructions forming a document identifier; and instructions forwarding the identifier to the party (col. 6, lines 44-67).

As per claim 3, Pickett teaches of instructing which facilitate verbally feeding back the identifier to the entity which forwarded same to the party (col. 4, lines 32-44).

As per claim 4, Pickett discloses of instructions to acknowledge the feedback identifier (col. 4, lines 32-44).

As per claim 5, it is taught by Pickett wherein the instructions include instructions for providing name and address information from at least one of the databases associated with the telephone number (col. 4, lines 32-44).

As per claim 9, it is taught by Pickett of executable instructions for placing a call, via the telephone network, to a provided telephone number of the party; and additional executable instructions to determine that the call has been answered and another communication link has been opened (col. 2, line 66 through col. 3, line 14).

As per claim 10, it is disclosed by Pickett of executable instructions for forwarding to the party, via the second system, identity confirmatory information (col. 4, lines 32-44).

As per claim 11, Pickett teaches of executable instructions for requesting that the party feedback the identify confirmatory information via the telephone system (col. 4, lines 32-44).

As per claim 12, Pickett discloses of instructions for storing a plurality of responses received from the party (col. 4, lines 32-44).

As per claim 14, it is disclosed by Pickett of instructions to create a digital signature associated with the party (col. 4, lines 32-44).

As per claim 15, Pickett teaches of a method comprising establishing two different electronic communications paths whereby a first path is established, and using information obtained thereby establishing an address to open the second path; verifying the identity of a party who has established the first path; presenting a document via the first path and, in response thereto, audibly receiving from the party, via the second path, a predetermined document identifier (col. 2, line 49 through col. 3, line 14; col. 6, lines 35-44; and as shown in Figure 1).

As per claim 16, Pickett discloses of transmitting the document identifier via the first path to the party (col. 6, lines 44-67).

As per claim 17, it is taught by Pickett of evaluating the accuracy of the transmitted document identifier (col. 4, lines 32-44).

As per claim 18, it is disclosed by Pickett of creating a digital signature associated with the presented document (col. 4, lines 32-44).

As per claim 20, Pickett discloses of interrogating at least one third-party database to evaluate the trustworthiness of the address (col. 4, lines 32-44).

As per claim 21, it is taught by Pickett of evaluating the address with respect to selected mail delivery information associated with the party (col. 4, lines 32-44).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickett, US Patent 6,012,144 in view of Campbell, WO 02/21258.

As per claims 6 and 22, Pickett fails to teach wherein the interrogating instructions include instructions for carrying out a geographic correlation between a provided telephone number and a geographical identifier/address associated with the party. It is disclosed by Campbell of interrogating instructions include instructions for carrying out a geographic correlation between a provided telephone number and a geographical identifier associated with the party (page 3, paragraph 10 through page 4, paragraph 14). It is obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply the use of geographic information wherein the teachings of Campbell recite motivation by reciting of determining if the location of user public and private information, see page 3, paragraph 10.

As per claim 5, Campbell is relied upon for disclosing wherein the geographical identifier comprises a postal zone code associated with the party (page 3, paragraph 10 through page 4, paragraph 14), please refer above for the motivation of applying the teachings of Campbell to the disclosure of Pickett.

As per claim 6, the teachings of Campbell are relied upon for disclosing executable instructions for correlating the postal zone code with a switching location, associated with the telephone number, which is part of the telephone system (page 3, paragraph 10 through page 4, paragraph 14), please refer above for the motivation of applying the teachings of Campbell to the disclosure of Pickett.

8. Claim 13 and 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pickett, US Patent 6,012,144 in view of Kanevsky, US Patent 6,092,192.

Pickett fails to teach of comparing current audio responses from the party with previously received responses from the party. It is disclosed by Kanevsky of comparing current audio responses from the party with previously received responses from the party (col. 2, lines 9-14). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply verifying speech patterns. The teachings of Kanevsky recite motivation for the application of verifying speech patterns by disclosing that each person can be uniquely identified by their voice (col. 2, lines 9-14).


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-3:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CR


August 20, 2006

CHRISTOPHER REVAK
PRIMARY EXAMINER

 8/20/06